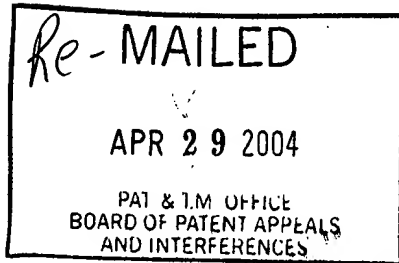


The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.

Paper No. 19

UNITED STATES PATENT AND TRADEMARK OFFICE

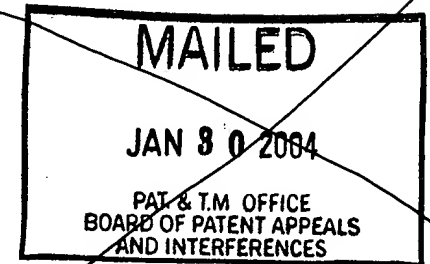
BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES



Ex parte ANTHONY N. CABOT

Appeal No. 2004-0112  
Application 09/654,212

ON BRIEF



Before ABRAMS, MCQUADE, and NASE, Administrative Patent Judges.

MCQUADE, Administrative Patent Judge.

DECISION ON APPEAL

Anthony N. Cabot appeals from the final rejection of claims 1 through 7 and 21 through 32, all of the claims pending in the application.

THE INVENTION

The invention relates to a method of playing poker.

Representative claim 1 reads as follows:

1. A method for playing a poker game, comprising in combination:  
dealing, face up, a NxN array of cards;  
selecting none, some, or all of the cards to be held in the NxN array of cards of any said cards within said NxN array;

Appeal No. 2004-0112  
Application 09/654,212

dealing new cards to replace unselected cards within said NxN array; and  
determining the poker hand rankings of predefined N card arrangements.

#### THE PRIOR ART

The references relied on by the examiner to support the final rejection are:

Dietz, II (Dietz)	5,704,835	Jan. 6, 1998
Holmes, Jr. et al. (Holmes)	6,220,959	Apr. 24, 2001

#### THE REJECTIONS

Claims 1, 2, 4 through 6, 21 through 26 and 29 through 32 stand rejected under 35 U.S.C. § 102(e) as being anticipated by Holmes.

Claim 7 stands rejected under 35 U.S.C. § 103(a) as being unpatentable over Holmes.

Claims 3, 27 and 28 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Holmes in view of Dietz.

Attention is directed to the brief (Paper No. 16) and answer (Paper No. 17) for the respective positions of the appellant and examiner regarding the merits of these rejections.

DISCUSSION

I. The 35 U.S.C. § 102(e) rejection of claims 1, 2, 4 through 6, 21 through 26 and 29 through 32 as being anticipated by Holmes

Anticipation is established only when a single prior art reference discloses, expressly or under principles of inherency, each and every element of a claimed invention. RCA Corp. v. Applied Digital Data Sys., Inc., 730 F.2d 1440, 1444, 221 USPQ 385, 388 (Fed. Cir. 1984). It is not necessary that the reference teach what the subject application teaches, but only that the claim read on something disclosed in the reference, i.e., that all of the limitations in the claim be found in or fully met by the reference. Kalman v. Kimberly Clark Corp., 713 F.2d 760, 772, 218 USPQ 781, 789 (Fed. Cir. 1983), cert. denied, 465 U.S. 1026 (1984).

Holmes discloses an electronic gaming machine for playing a multi-hand video poker game. The game involves a 5-by-5 matrix of twenty-five cards providing twelve possible five-card hands and corresponding betting lines: the five horizontal rows, the five vertical columns and the two diagonals. In one embodiment of play (see column 4, line 6 et seq. and patent claims 1 and 6), wagers are made by a player on selected five-card betting lines, the cards are electronically shuffled and dealt face-up in a 5-by-5 array, either no cards or one card in each horizontal row

is selected by the player to be held, each held card is duplicated once in an adjacent card position in the same row, the non-selected cards are discarded and replaced with new cards, and a pay-out table is used to determine and make pay-outs for any winning hands. The cards in each row may be dealt from separate standard decks of fifty-two cards having the four traditional suits (spades, hearts, diamonds and clubs) or all of the cards in the game may be dealt from a single such deck (see column 4, lines 39 through 47), the suits of the cards may or may not be used in determining winning card combinations (see column 4, lines 53 through 64) and, in a variation of the basic format, pay-outs in addition to those mentioned above may be made for winning hands achieved on the initial deal of the cards (see column 6, lines 37 through 45).

As framed and argued by the appellant, the dispositive issues with respect to the anticipation rejection are whether Holmes meets the selecting/holding limitations in independent claims 1, 21 and 29, and the 52 card deck limitation in claim 24, which depends indirectly from claim 21, and claim 29. As indicated above, claim 1 recites the step of "selecting none, some, or all of the cards to be held in the NxN array of cards of any said cards within said NxN array." Independent claim 21

recites the step of "selecting some, none, or all of any of the cards within said NxN array of cards to be held," claim 24 recites the step of "providing a 52 card deck for dealing and replacing said cards," and claim 29 recites a method for playing a poker game utilizing "a standard 52 card playing deck" comprising, inter alia, the step of "permitting a player to hold none, some, or all of any of said 25 cards."

The examiner's finding (see pages 4 and 6 in the answer) that the selecting/holding limitations in claims 1, 21 and 29 are met by Holmes' teaching that one card from each row may be selected and held is not well taken. The reference in these limitations to "any" of the dealt cards defines over Holmes' restriction as to which cards (one per row) may actually be selected and held. Nonetheless, the alternatively-phrased selecting/holding limitations do find full response in Holmes' disclosure that none of the cards may be selected and held. In addition, the 52 card deck limitations in claims 24 and 29 find full response in Holmes' teaching that all of the cards in the game can be dealt from a single standard deck of fifty-two cards. Holmes' disclosure that none of the cards has to be selected and held and that the suits of the cards do not have to be used to determine winning card combinations refutes the appellant's

argument (see pages 8 and 9 in the brief) that the Holmes game would be inoperative if played with a single deck. Moreover, there is nothing in the 52 card deck limitations in claims 24 and 29 which excludes, or is otherwise inconsistent with, Holmes' alternative use of multiple decks to play the game.

Thus, the appellant's position that the subject matter recited in claims 1, 21, 24 and 29 distinguishes over that disclosed by Holmes is not persuasive. We shall therefore sustain the standing 35 U.S.C. § 102(e) rejection of these claims as being anticipated by Holmes. As our rationale for sustaining this rejection with respect to independent claims 1, 21 and 29 differs from that advanced by the examiner, we designate our action in this regard as a new ground of rejection under 37 CFR § 1.196(b) to allow the appellant a fair opportunity to react thereto (see In re Kronig, 539 F.2d 1300, 1302-03, 190 USPQ 425, 426-27 (CCPA 1976)).

We also shall sustain the standing 35 U.S.C. § 102(e) rejection of dependent claims 2, 4 through 6, 22, 23, 25, 26 and 30 through 32 since the appellant has not challenged such with any reasonable specificity, thereby allowing these claims to stand or fall with independent claims 1, 21 and 29 (see In re

Appeal No. 2004-0112  
Application 09/654,212

Nielson, 816 F.2d 1567, 1572, 2 USPQ2d 1525, 1528 (Fed. Cir. 1987)).

II. The 35 U.S.C. § 103(a) rejection of claim 7 as being unpatentable over Holmes

Claim 7, which depends indirectly from claim 1, recites the step of allowing the purchase of 12 N card arrangements (five vertical lines, five horizontal lines and two diagonal lines) sequentially in a predetermined order. Implicitly conceding that Holmes does not disclose such a step, the examiner concludes that it would have been obvious to a person having ordinary skill in the art to add same to the Holmes method "to provide a more challenging game where the outcome (win or lose) becomes more difficult and therefore more satisfying" (answer, page 6). This conclusion must fall as the examiner has not advanced any factual support therefor.

Accordingly, we shall not sustain the standing 35 U.S.C. § 103(a) rejection of claim 7 as being unpatentable over Holmes.

III. The 35 U.S.C. § 103(a) rejection of claims 3, 27 and 28 as being unpatentable over Holmes in view of Dietz

Claim 3, which depends from claim 1, further defines the NxN array of cards as "a 3x3 array of cards." Claims 27 and 28, which depend indirectly from claim 21, define N as "three." The

examiner acknowledges that Holmes does not respond to these limitations and turns to Dietz to overcome this deficiency.

Dietz discloses an electronic video slot machine designed to display symbols in any of various row and column arrangements. The preferred arrangement is three rows and three columns forming a 3-by-3 matrix (see column 3, line 50, through column 4, line 3). A player may bet various combinations of the displayed symbols including those arranged along rows, columns and diagonals, respectively (see column 4, lines 4 through 13).

In proposing to combine Holmes and Dietz to reject claims 3, 27 and 28, the examiner concludes that it would have been obvious to a person having ordinary skill in the art "to change the 5x5 array of Holmes to 3x3 array as taught by Dietz in order to give players different options or to provide a simpler game" (answer, page 5). Dietz makes it clear, however, that the preferred 3-by-3 symbol matrix is specific to a slot machine environment (for example, see Dietz's background discussion in columns 1 and 2). Similarly, Holmes makes it clear that the 5-by-5 matrix disclosed therein is specific to a poker environment. The only suggestion for combining these disparate references in the manner proposed by the examiner stems from hindsight knowledge impermissibly derived from the appellant's disclosure.



Appeal No. 2004-0112  
Application 09/654,212

Thus, we shall not sustain the standing 35 U.S.C. § 103(a) rejection of claims 3, 27 and 28 as being unpatentable over Holmes in view of Dietz.

#### SUMMARY

The decision of the examiner to reject claims 1 through 7 and 21 through 32 is affirmed with respect to claims 1, 2, 4 through 6, 21 through 26 and 29 through 32 and reversed with respect to claims 3, 7, 27 and 28. In addition, the affirmance with regard to independent claims 1, 21 and 29 constitutes a new ground of rejection under 37 CFR § 1.196(b).

In addition to affirming the examiner's rejection of one or more claims, this decision contains a new ground of rejection pursuant to 37 CFR § 1.196(b) (amended effective Dec. 1, 1997, by final rule notice, 62 Fed. Reg. 53,131, 53,197 (Oct. 10, 1997), 1203 Off. Gaz. Pat. & Trademark Office 63, 122 (Oct. 21, 1997)). 37 CFR § 1.196(b) provides, "A new ground of rejection shall not be considered final for purposes of judicial review."

Regarding any affirmed rejection, 37 CFR § 1.197(b) provides:

(b) Appellant may file a single request for rehearing within two months from the date of the original decision . . . .

Appeal No. 2004-0112  
Application 09/654,212

37 CFR § 1.196(b) also provides that the appellant, WITHIN TWO MONTHS FROM THE DATE OF THE DECISION, must exercise one of the following two options with respect to the new ground of rejection to avoid termination of proceedings (37 CFR § 1.197(c)) as to the rejected claims:

(1) Submit an appropriate amendment of the claims so rejected or a showing of facts relating to the claims so rejected, or both, and have the matter reconsidered by the examiner, in which event the application will be remanded to the examiner. . . .

(2) Request that the application be reheard under § 1.197(b) by the Board of Patent Appeals and Interferences upon the same record. . . .

Should the appellant elect to prosecute further before the Primary Examiner pursuant to 37 CFR § 1.196(b)(1), in order to preserve the right to seek review under 35 U.S.C. §§ 141 or 145 with respect to the affirmed rejections, the effective date of the affirmance is deferred until conclusion of the prosecution before the examiner unless, as a mere incident to the limited prosecution, the affirmed rejection are overcome.

If the appellant elects prosecution before the examiner and this does not result in allowance of the application, abandonment or a second appeal, this case should be returned to the Board of Patent Appeals and Interferences for final action on the affirmed rejections, including any timely request for reconsideration thereof.

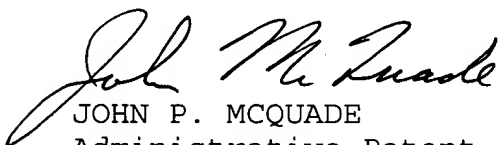
Appeal No. 2004-0112  
Application 09/654,212

No time period for taking any subsequent action in  
connection with this appeal may be extended under 37 CFR  
§ 1.136(a).

AFFIRMED-IN-PART; 37 CFR § 1.196(b)



NEAL E. ABRAMS  
Administrative Patent Judge



JOHN P. MCQUADE  
Administrative Patent Judge



JEFFREY V. NASE  
Administrative Patent Judge

)  
)  
)  
) BOARD OF PATENT  
)  
) APPEALS AND  
) INTERFERENCES  
)  
)  
)  
)  
)  
)  
)  
)

JPM/kis

Appeal No. 2004-0112  
Application 09/654,212

VICTOR J. GALLO  
3 KENNESAW ROAD  
HENDERSON, NV 89052